

REMARKS/ARGUMENTS

The Examiner is requiring election of a single Group of claims for further prosecution.

The Claims have been divided into Groups as follows:

Group I: Claims 1-18, 65, 66, drawn to a polynucleotide.

Group II: Claims 19-44, drawn to a polypeptide and kit.

Group III: Claims 45-47, drawn to a method for reverse transcribing RNA.

Group IV: Claims 48-62, drawn to a method of identifying mutant polypeptide.

Group V: Claims 63-64, drawn to a method of obtaining enzyme.

In addition, the Examiner is requiring an election of species. Applicant must elect a single mutation as recited in claims 1, 2, 10, 19, 20, 23, 28 31, 40, 45, 46, 47, **and one (1) polynucleotide sequence (SEQ ID NO:)** or one (1) polypeptide sequences (SEQ ID NO:). The sequence election should correspond with the elected mutation. Applicant must specifically identify each of the corresponding SEQ ID NO:X or SEQ ID NO: Y for the sequence along with the corresponding claims.

Applicants elect, with traverse, Group I, Claims 1-18, 65, 66 (drawn to a polynucleotide) for examination.

Applicants also provisionally elect the following species, for examination purposes only, (1) polynucleotide sequences encoding for polypeptides having 80% identity to residues 13-555 of SEQ ID No:26, wherein said polypeptide has at least one mutation, at position **W550** (position 827 of the Taq polymerase wild-type) (at least claims 1-18, 65 and 66 readable thereon); and (1) polynucleotide SEQ ID No:21 (at least claims 1-18, 65 and 66 readable thereon).

Restriction is only proper if the claims of the restricted groups are independent or patentably distinct and there would be a serious burden placed on the Examiner if restriction is not required (MPEP §803). The burden is on the Examiner to provide reasons and/or examples to support any conclusion in regard to patentable distinction (MPEP §803). Moreover, when citing lack of unity of invention in a national stage application, the Examiner has the burden of explaining why each group lacks unity with each other group specifically describing special technical features in each group (MPEP § 1893.03(d)).

The Office has asserted that Groups I - V do not relate to a single general inventive concept under PCT Rule 13.1 because under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

“Where a group of inventions is claimed in an application, the requirement of unity of invention shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression “special technical features” shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art. Barnes et al. (U.S. Patent No. 6,214,557, 2001) teach a purified polynucleotide which encodes a polypeptide comprising an amino acid sequence having at least 80% identity to residues 13-555 of SEQ ID NO:26, wherein the polypeptide has at least one mutation in amino acids 461-490 of SEQ ID NO: 26 or at a position selected from the group consisting of H203, F205, T232, E253, Q257, D274, L275, I276, V309, I322, A331, L332, D333, Y334, \$335, I361, R374, A384, T387, Y419, P493, M498, G499, M502, L503, V506, R518, A523, A526, P539, E543, and W550, and wherein said polypeptide has DNA polymerase activity (See ISR and reference). Thus, the shared technical feature of the groups is not a “special technical feature”, unity of invention between the groups does not exist..”

Annex B of the Administrative Instructions under the PCT at (b) Technical Relationship states:

“The expression “special technical features” is defined in Rule 13.2 as meaning those technical features that defines a contribution which each of the inventions, considered as a whole, makes over the prior art. The determination

is made on the contents of the claims as interpreted in light of the description and drawings (if any).”

Applicants respectfully submit that the Examiner has not provided any indication that the contents of the claims *interpreted in light of the description* was considered in making the assertion of a lack of unity and therefore has not met the burden necessary to support the assertion.

Furthermore, 37 C.F.R. § 1.475(b) states in pertinent part:

“An international or a national stage application containing claims to different categories of invention will be considered to have unity of invention if the claims are drawn only to one of the following combinations of categories:

(2) A product and a process of use of said product; . . .”

In addition, The MPEP §806.03 states:

“Where the claims of an application define the same essential characteristics of a *single* disclosed embodiment of an invention, restriction there between should never be required. This is because the claims are not directed to distinct inventions; rather they are different definitions of the same disclosed subject matter, varying in breadth or scope of definition.”

Applicants respectfully submit that the Office has not considered the relationship of the inventions of Groups I-V with respect to 37 C.F.R. § 1.475(b)(2) and MPEP §806.03. Therefore the burden necessary according to MPEP § 1893.03(d) to sustain the conclusion that the groups lack of unity of invention has not been met.

Accordingly, and for the reasons presented above, Applicants submit that the Office has failed to meet the burden necessary in order to sustain the requirement for restriction.

Applicants therefore request that the requirement for restriction be withdrawn.

Applicants make no statement regarding the patentable distinctness of the species, but note that for restriction to be proper, there must be a patentable difference between the species as claimed. MPEP § 808.01(a). The Office has not provided any reasons or examples to support a

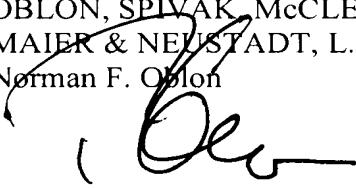
conclusion that the species are indeed patentably distinct. Accordingly, Applicants respectfully submit that the restriction is improper, and Applicants' election of species is for examination purposes only. Applicants respectfully request that the election requirement be withdrawn.

Applicants respectfully submit that the above-identified application is now in condition for examination on the merits, and early notice thereof is earnestly solicited.

Respectfully Submitted,

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